

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Josef Prassler et al.

Group Art Unit: 1636

Serial No.: 10/522,535

Examiner: Nancy Treptow Vogel

Filed: October 12, 2005

Title: NOVEL TRICISTRONIC VECTORS AND USES THEREOF

Docket No.: MS027US

REQUEST FOR CONTINUED PROSECUTION UNDER 37 CFR §1.114

United States Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Dear Examiner:

Applicant requests continued prosecution of the captioned application. A Notice of Allowance was mailed on July 29, 2009. This request is timely filed. Applicant does not believe that any fees other than the RCE fee are required in conjunction with this filing. In the event that any fees are due in the present application, Applicant authorizes the Commissioner to charge any necessary fees to Deposit Account No. 50-4520.

Applicant requests continued prosecution in the captioned application in order for the Examiner to consider the Lohning et al. PCT/EP00/06968 (WO2001/05950) publication of January 25, 2001. In the non-final office action mailed June 26, 2008, Examiner cited Lohning et al. (US2002/0034733) as 35 U.S.C. § 103(a) art. In the responsive Amendment and Request for Reconsideration filed by applicant on September 26, 2008, applicant stated, in relevant part:

A. Lohning is not available as prior art under §102(e) prior art

Pursuant to MPEP 706(l)(2), Applicant states: At the time the invention of Application No. 10/522,535 was made, Application No. 10/522,535 and Patent No. 6,753,136, previously published as Lohning (US 2002/0034733), were owned by MorphoSys AG.

The Examiner cites Lohning (US 2002/0034733) as prior art available for use under §103(a) non-obviousness. §103(c), however, provides, in relevant part, that subject matter which qualifies as prior

art only under §102(e) shall not preclude patentability under this section where the subject matter and the claimed invention were owned by the same person. The present application is a national stage application of PCT/IB03/03681 filed on July 30, 2003, which claims priority under §119(e) from Provisional Application No. 60/399,150 filed on July 30, 2002. See U.S. Patent Publication No. 20060121563. Pursuant to MPEP §706.02 subsection VI(D), the effective filing date of a U.S. application, which claims the benefit under §119(e) to a provisional application, is the filing date of the provisional, July 30, 2002. Lohning (US 2002/0034733) was published on March 21, 2002. This is less than a year before the effective filing date of the present application; accordingly, Lohning is not available as prior art under §102(b). Lohning's §102(e) date is July 20, 2000, the date of the PCT filing. Lohning and the present application, however, were both owned by MorphoSys AG at the time the invention of the present application was made. The assignment of Lohning to MorphoSys AG is recorded at Reel/Frame 013103/0668. The assignment of the present application is recorded at Reel/Frame 016633/0679. As the provisions of §103(c) are satisfied, Lohning (US 2002/0034733) is unavailable in the consideration of non-obviousness under §103(a).

Since Lohning is unavailable in the consideration of non-obviousness, pursuant to §103(c); Burger alone cannot support a rejection of non-obviousness. Withdrawal of the rejection respectfully is requested.

This statement while accurate with regard to the U.S. family member US2002/0034733, overlooked the fact that the PCT application, PCT/EP00/06968 (WO2001/05950), from which US2002/0034733 is a continuation, published on January 25, 2001. Applicant asserts that the remarks made in the Amendment and Request for Reconsideration filed by applicant on September 26, 2008 were made without intent to deceive the patent examiner. Applicant requests continued examination in the present application so that PCT/EP00/06968 (WO2001/05950) can be taken into consideration by the Examiner.

Prior to the entry of the claims set forth below, claims 1-19 were pending.

Please amend the application as set for below:

Amendments to the claims begin on **page 4**

Remarks begin on **page 6**